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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,248	01/18/2001	Jason Weber	44431-233644 (13237-2750)	8161
47766 7590 03/17/2008 VIERRA MAGEN/MICROSOFT CORPORATION 575 MARKET STREET, SUITE 2500 SAN FRANCISCO, CA 94105			EXAMINER BASHORE, WILLIAM L	
			ART UNIT 2176	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/765,248	Applicant(s) WEBER ET AL.	
	Examiner William L. Bashore	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-11,14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2 and 4-6 is/are allowed.
- 6) ☒ Claim(s) 7,9-11,14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2176

DETAILED ACTION

1. This Action is in response to amendment filed 12/14/2007.
2. Claims 1-11,13-26 are pending. Claims 23-26 have been withdrawn. Claims 3, 8, 13, 15 have been canceled. Claims 1-2, 4-7, 9-11, 14, 16-22 are examined on the merits. Claims 1, 7, 11 are independent.
3. Effective filing date is **1/18/2001**.

Allowable Subject Matter

4. **Claims 1-2, 4-6** are allowed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **The claimed invention (as claimed in claims 11, 14, 16-22) is directed to non-statutory subject matter.**

In regard to independent claim 11, said claim is directed to a system, however, the instant specification and the claim language do not specify that the system is directed to hardware. As such, the language of the claim merely describes a computer program per se (i.e. software). This raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, Which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

In regard to dependent claims 14, 16-22, said claims do not recite statutory subject matter, therefore said claims are rejected for fully incorporating the deficiencies of their respective base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claim 11, 16, and 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Beauregard et al (US 5974413, issued Oct 26, 1999).**

Claim 11, Beauregard teaches the claimed limitation of *an application program for creating the electronic document and creating a request for information to obtain selected reference material, wherein the electronic document comprises a string having a unique identifier associated with the string, wherein the request for information comprises the unique identifier; a reference engine for receiving the request for information from the application program, selecting one of a plurality of reference material sources based upon the request for information, and accessing the selected reference material source to obtain the selected reference material*. For example, Specifically, Beauregard discloses a user interface that allows a user that is writing an e-mail message to mention several companies by replacing all stock symbols with the actual company name in a timely manner that is relevant to the user, including other information such as sales/earnings information which is updated periodically from a subscription service (col 52, lines 6-24). The examiner interprets the subscription service as a functional equivalent to the claimed reference material source. Beauregard's "RD" is a unique identifier which is replaced with a string "Royal Dutch Petroleum Company (RD)" which is provided to the author of the email as the user types the symbols. The examiner interprets the user typing the short symbol identifier as a request that should be replaced with the full name of the company, allowing the user to work in avoid time consuming typing (Beauregard, col 52, line 10) and allowing a user to use their everyday words to operate a computer in a highly efficient way

Art Unit: 2176

(Beauregard, Abstract section), which can be used in conjunction with the Microsoft Outlook97 directory (col 50, line 32).

It is additionally noted that Beauregard teaches monitoring of user actions via Figure 9 (monitoring if a user has released the space bar). If the space bar is released, a pop-up menu (prompt) appears requesting information (see also Figure 10 items 1040, and 1050 – Charm Box).

Claim 16, Beauregard teaches *wherein the application program is a word processing program having a selected language, and wherein the request for information comprises an identifier for the selected language.*

Specifically, Beauregard discloses an ActiveWord system that uses a natural language by allowing a single-word logic interface and that every word entered by a user has a natural language meaning (ie., word means word processor)(col 8, lines 50-65). So, the user by entering ‘word’ is requesting for the longer meaning of the word, namely “word processor”. The user can use their everyday language or user defined words (see Abstract section).

Claim 22, Beauregard teaches *wherein one of the plurality of reference material sources is a remote server* Col 52, lines 25-47 disclose a company’s supplier database that services queries for names sought for composing email messages, located on a LAN/WAN. The examiner interprets the service of the database must inherently be provided by a server.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 7, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehani et al (US 5946687, issued Aug 1999), in view of DeLorme et al. (US 5,948,040), and in view of Lapstun et al. (US 6,813,558).**

Regarding amended independent Claim 7, Gehani discloses *receiving a request for selected reference material; determining that an identity of a user of the selected reference material is relevant to the selected reference material and if so: creating a request for information requesting the selected reference material and identifying the user; upon creation of the request, selecting a reference material source based upon the requesting for information; accessing the selected reference material source to obtain the selected reference material; and after the step of accessing, providing the selected reference material in a manner that is relevant to the identified user.* Gehani discloses a Geo-enabled personal information manager that allows a user to request maps, weather and other geographic information specific to an address by locating a specific record where the user enters or selects a name/identifier on the display and the personal information manager retrieves the corresponding record from a database, including addresses utilizing the location identifier to format a request for that type of geographic information and sends the request to the geographic information server, where the server processes the request and delivers geographic information specific to the location identifier back to the personal information manager for display to the user (col 2, lines 1-16). See also (col 5, lines 25-35).

It is noted that Gehani's database typically incorporates a form of identifier for matching database information to items associated with a user of a personal information manager.

Additionally, for example, Fig 2 shows that a user (16) can request weather information or Maps, routes and yellow pages information from the PIM (12), which processes the request via the geoserver (20) for weather information that resides on the weather info source (24) or for the maps, routes and yellow pages information that resides on the maps, routes & yellow pages database. The Examiner interprets the weather info, maps, routes and yellow pages as reference material. The Examiner interprets Gehani's teaching of a contact name or similar record identifier as functionally equivalent to the identity of a user because it is meant to convey personal information about a user or person to provide requested information that is relevant to a user, because it is data that the user does

Art Unit: 2176

not have at the time of the request and is further compared to the user's request and provided to the user to server a purpose of obtaining geographical information relating to personal information (col 1, lines 39-45).

Gehani does not specifically teach "*request for information includes the identity of a user*", and "*directions are based in part on the identity of the user*". However, DeLorme teaches a travel planning system whereby a user logs onto a TRIPS system with a user identity, therefore subsequent map route searches are associated with said user's identity (DeLorme at least column 34 lines 26-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply DeLorme to Gehani, providing Gehani the benefit of logging on so as to create searches for individual registered users.

Gehani does not specifically teach "*wherein directions to the destination begin where the user is geographically located*". However, Lapstun teaches a computer system (Netpages) comprising a user using his/her current location as a point of origin (Lapstun at least Figure 15, 16). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Lapstun to Gehani, providing Gehani the benefit of beginning a search at one's geographical point of origin, so as to create a complete route to a destination.

Claim 9, Gehani teaches *wherein the selected reference material source is one of a plurality of reference material sources, and at least one of the reference material sources is a remote Server* (ie., GeoServer for serving maps (#22) and routes and yellow page info to user)(fig 1, item 20).

Claim 10, Gehani teaches *further comprising the step of accessing the selected reference material source ' via a network* (ie., network)(fig 2, item 34).

9. **Claims 14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beauregard et al (US 5974413, issued Oct 26, 1999), in view of Microsoft Outlook 2000 (version 9.0.0.4527; copyrighted 1999)(hereinafter "Outlook", as previously cited).**

Art Unit: 2176

Claim 14, As indicated in the above discussion, Beauregard discloses every limitation of Claim 11. Beauregard fails to teach, but Outlook teaches *wherein a user's identity is relevant to the request for information, and wherein the request for information comprises an identifier for the user* (ie., the sought name is a valid name in the address book or global list if it matches an entry in the list)(Outlook, page 1, item a).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Beauregard to include providing the sought after name upon determining that the name is valid by matching it against an address list of valid entries as taught by Outlook, providing the benefit of allowing an investment advisor to conveniently write an email message to his client about companies using the Microsoft Outlook email program (col 52, lines 1-20; col 50, line 34).

Claim 18, As indicated in the above discussion, Beauregard discloses every limitation of Claim 11. Beauregard fails to teach, but Outlook teaches *wherein one of the plurality of reference material sources is an address book associated with an electronic mail application program* (ie., the sought name is a valid name in the address book or global list if it matches an entry in the list)(Outlook, page 1, item a).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Beauregard to include providing the sought after name upon determining that the name is valid by matching it against an address list of valid entries as taught by Outlook, providing the benefit of allowing an investment advisor to conveniently write an email message to his client about companies using the Microsoft Outlook email program (col 52, lines 1-20; col 50, line 34).

Claim 19, As indicated in the above discussion, Beauregard discloses every limitation of Claim 11. Beauregard fails to teach, but Outlook teaches *wherein the request for information comprises a unique identifier associated with an entry in the address book, and wherein the reference engine selects the address book as the selected reference material source based upon the unique identifier* (ie., the sought name is a valid name in the address book or global list if it matches an entry in the list; in the "To" field of the Message, if the author types a name requested, Outlook validates the name against the names stored in the address books and upon a successful validation, returns a name associated with the unique identifier entered by the user. The user does not have to

Art Unit: 2176

specify which address book to look in, the Outlook program automatically finds the name associated from the appropriate address book)(Outlook, page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Beauregard to include providing the sought after name upon determining that the name is valid by matching it against an address list of valid entries as the application program finds the name in the appropriate address list as taught by Outlook, providing the benefit of allowing an investment advisor to conveniently write an email message to his client about companies using the Microsoft Outlook email program (col 52, lines 1-20; col 50, line 34).

10. **Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beauregard et al (US 5974413, issued Oct 26, 1999), in view of Microsoft Word (see attached Non Patent Literature, copyright 1999)(hereinafter "MS-Word").**

Claim 17, As indicated above, Beauregard discloses every limitation of claim 11. Beauregard fails to disclose, but MS-Word teaches *wherein one of the plurality of reference material sources is a dictionary in a first language and another one of the plurality of reference material sources is a dictionary in a second language* (ie., allows for automatically detection of language for the application)(MS-Word, page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Beauregard to include automatic detection of language of the application as taught by MS-Word, providing the benefit of an electronic document authoring/creation system with valid information which are well know in the art for validating spelling and grammar (MS-Word).

11. **Claims 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beauregard et al (US 5974413, issued Oct 26, 1999), in view of Thompson (US 2001/0003183, filed Jun 15, 1998).**

Art Unit: 2176

Claim 20, As indicated above, Beauregard discloses every limitation of claim 11. Beauregard fails to disclose, but Thompson teaches *wherein the request for information comprises key words summarizing the content of the electronic document* (ie., abstract concept is prepared for a keyword)(para 18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Beauregard to include finding the abstract concept for a keyword as taught by Thompson, providing the benefit of a library of query dictionaries that relates keyword to abstract concepts for complex languages.

Claim 21, Beauregard teaches *wherein one of the plurality of reference material sources is a remote server*. Col 52, lines 25-47 disclose a company's supplier database that services queries for names sought for composing email messages, located on a LAN/WAN. The examiner interprets the service of the database must inherently be provided by a server.

Response to Arguments

12. Applicant's arguments filed 12/14/2007 have been fully and carefully considered but they are not persuasive.

Initially, it is noted that Applicant's amendment to the independent claims significantly changes the scope of the claimed invention when interpreted as a whole.

Applicant's arguments directed to instant claims 1-2, 4-6, and regarding claims 7, 9-10 are currently moot in view of allowable subject matter and new grounds of rejection.

Applicant argues on pages 9-10 of the amendment that the cited art does not teach claim 11. The examiner respectfully disagrees. As explained in the last action, in additional support of the instant rejections, Beauregard teaches various resources such as Encyclopedia, and shared word bases (Beauregard Figure 12). Beauregard's stock symbol can be reasonably interpreted as a string associated with a company. It is additionally noted that Beauregard teaches monitoring of user actions via Figure 9 (monitoring if a user has released the space bar). If the space bar is released, a pop-up menu (prompt) appears requesting information (see also Figure 10 items 1040, and 1050 – Charm Box).

Conclusion

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571)272-4088. The examiner can normally be reached on 9:00 am - 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William L. Bashore/
William L. Bashore
Primary Examiner
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March 1, 2008